

REMARKS/ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

Since the present amendment raises no new issues for consideration and, in any event, places the present application in better condition for consideration on appeal, it is respectfully requested that this amendment be entered under 37 CFR 1.116 in response to the last Office Action dated January 12, 2006, which made final rejections as to the pending claims.

A. STATUS OF THE CLAIMS

Claims 1-3 and 5-22 as amended are presented for continued prosecution. Claim 4 has been cancelled and the limitations of claim 4 are incorporated into claim 1. No new matter has been added.

B. REJECTIONS UNDER 35 U.S.C. § 112, FIRST AND SECOND PARAGRAPH

The Examiner has rejected the subject matter of claim 4 as failing to comply with the written description requirement and being indefinite. Claim 4 has been cancelled but claim 1, as amended, includes the limitations of original claim 4, except that the possibility of D₁ and D₂, being OH has been removed. Support is found, for example, at page 8, lines 11-23 and claim 4 as filed. Note the passages therein which state that D₁ and D₂ are other than OH and that the terminal branching can take up to 16 equivalents of drugs. Note also the figures, examples and claim 18 which show progressive levels of branching. It is respectfully urged that the pending claims properly comply with the written description requirement of 35 U.S.C. § 112, ¶ 1. The examples and figures corresponding thereto clearly show one of ordinary skill how to build the terminally branched polymer containing one or more (up to 16) benzyl or related groups thereon. The examples, especially when read in view of the remainder of the specification, show one skilled in the relevant art how to make the claimed invention without undue experimentation. It is respectfully requested that the rejections be reconsidered and removed.

C. REJECTION UNDER 35 U.S.C. §103

The Examiner has maintained the rejection of the subject matter of claim 1-22 as being obvious in view of commonly assigned PCT publication WO 99/53951, (hereinafter "WO '951). Reconsideration and removal of the rejection in view of the comments made herein is respectfully requested.

WO '951 discloses terminally branched polymers, linkers and polymeric conjugates. Contrary to the position of the Examiner, the claimed invention is urged to be patentably distinguishable thereover. The claims presented herein require the terminal groups to include one or more moiety of formula (IV) or (V). Each of these moieties has an aromatic group which facilitates the benzyl-elimination reaction to regenerate or release the drug or biologically active moiety attached thereto. The possibility of having each terminal group of the claimed invention not including an aromatic group for its benzyl-elimination properties has been excluded from the claims.

WO'951 describes the formation of terminally branched polymers but it is believed that it does not provide the specific guidance required to make the claimed invention which would be required for a proper rejection. The law on this aspect of 35 U.S.C §103 is clear. Precedent requires that a finding of obviousness be supported by some teaching, suggestion, or motivation in the prior art to produce the claimed combination of elements. It is urged that the Examiner has not identified any suggestion, teaching, or motivation in the prior art that would have taught a person of ordinary skill in the field invention to arrive at the claimed invention. Furthermore, hindsight should not be permitted for the purpose of rejecting the claims.

D. FEES

This response is being filed with a shortened period for response. Thus, no further fees are believed to be required. If, on the other hand, it is determined that any further fees are due or

any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.


E. CONCLUSION

In view of the actions taken and arguments presented, it is respectfully submitted that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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